

REMARKS

I. Status of the Claims

Claims 1, 39, 40, 48, and 49 have been amended herein to incorporate the limitations recited in claim 5, with the exception of the fluorescent dye of formula (F2).

Claims 4 and 5 have been canceled.

Claim 10 has been amended to correct a typographical error.

Applicants acknowledge and thank the Examiner for indicating that claims 6-7 contain allowable subject matter.

II. Rejections Under 35 U.S.C. §§ 103/102

A. Matsunaga

The Examiner has rejected claims 1-5, 9-16, 21-22, 28-29, 31-32, 34-36, and 38-53 under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0054206 A1 to Matsunaga et al. ("*Matsunaga*") for the reasons disclosed on pages 2-4 of the Office Action. Applicants respectfully traverse this rejection.

According to the Examiner, *Matsunaga* teaches, among other things, a hair dyeing composition comprising an azomethine compound which is identical to the compound of formula F2 recited in claims 4 and 5. *Office Action*, page 2. Specifically, the Examiner contends that *Matsunaga* teaches all limitations of the present claims and thus anticipates the present invention. *Office Action*, page 3. In the alternative, the Examiner contends that because *Matsunaga* teaches an identical composition, "the properties applicant discloses and/or claims is necessarily present;" therefore, the

claimed invention would have been obvious to one skilled in the art. *Office Action*, page 3-4. Applicants disagree.

A prior art reference anticipates a claim of an application only if each and every limitation as set forth in each claim is found, either expressly or inherently, in a single reference. M.P.E.P. § 2131. Moreover, as part of a prima facie case of obviousness, the Examiner must demonstrate that each and every claim limitation is taught or suggested by the prior art. M.P.E.P. § 2143.03. In view of the present amendment, neither of these required showings has been met.

Indeed, *Matsunaga* does not teach or suggest each limitation of the claims as presently amended, specifically, the fluorescent dyes corresponding to formulae (F1), (F3), and (F4). Rather, every direct dye disclosed in the *Matsunaga* reference is an azomethine dye. See para. [0007] - [0013]. Accordingly, this reference cannot anticipate or render obvious the presently amended claims because it does not teach every single claim limitation. Applicants respectfully request that the Examiner withdraw this rejection.

Claim 47

With respect to claim 47, the Examiner has contended that *Matsunaga* teaches a process for dyeing hair that is the same as the process claimed in present claims 39-40, 47, and 49. *Office Action*, page 3. Applicants disagree with the Examiner's characterization of claim 47.

Applicants submit that claim 47 has nothing to do with a process for dyeing hair. In fact, claim 47 recites a process for coloring dark skin with a lightening effect. The Examiner has not identified a single place in the *Matsunaga* reference that deals with a

process for coloring dark skin. Nor has Applicants found a single mention of such a process in this reference. Accordingly, because *Matsunaga* does not teach or suggest a process for coloring dark skin with a lightening effect, Applicants respectfully request that the Examiner withdraw this improper rejection.

Claims 30 and 33

The Examiner has rejected claims 30 and 33 under 35 U.S.C. § 103(a) as unpatentable over *Matsunaga*, for the reasons disclosed on page 4 of the Office Action. Applicants respectfully traverse this rejection.

The Examiner admits that *Matsunaga* does not teach the presently claimed amounts for the oxidation bases and couplers. Nonetheless, the Examiner presently contends it would have been obvious for one skilled in the art to formulate a composition in conformance with the invention because the amounts disclosed in *Matsunaga* overlap with the amounts claimed. *Office Action*, page 4. Applicants disagree.

As discussed above, *Matsunaga* does not disclose or suggest hair dye compositions comprising fluorescent dyes corresponding to formulae (F1), (F3), and/or (F4). Accordingly, the further modification of this reference necessarily fails. Applicants respectfully request that the Examiner withdraw the rejection over claims 30 and 33.

B. Matsunaga in view of Rondeau

The Examiner has rejected claim 8 over *Matsunaga* in view of U.S. Patent No. 6,436,153 B2 to Rondeau ("*Rondeau*"), for the reasons disclosed on page 5 of the Office Action. Applicants respectfully traverse this rejection.

The Examiner admits that *Matsunaga* does not teach or suggest a fluorescent compound according to claimed formula (F4). *Id.* Thus, the Examiner relies on *Rondeau* for this missing disclosure. The Examiner reasons that, because *Matsunaga* suggests that other direct dyes can be used in its composition, one skilled in the art would have turned to *Rondeau* and selected one of its disclosed compounds, specifically the compound of formula (I4). *Id.* According to the Examiner, a person of skill in the art “would be motivated to incorporate the [compounds taught by *Rondeau*]” and such a modification “would be” obvious. Applicants disagree.

The only thing obvious about the Examiner’s rejection is the use of hindsight to reconstruct the claimed invention. Nothing in the *Rondeau* reference would have suggested to one skilled in the art to select the compound of formula (I4). Indeed, this compound is buried in a laundry list of at least ninety compounds. Col. 7- col. 16. And, moreover, it is not even referenced as a preferred compound. See col. 13, lines 51-53 (noting that compounds corresponding to I1, I2, I14, and I31 are particularly preferred).

Motivation requires much more than a mere mention in a document. The Federal Circuit has been quite clear on this point: “identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000) (internal citations omitted). Moreover, as recently explained by the Federal Circuit, rejections on obviousness grounds cannot be sustained by mere conclusory statements; rather, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn* 441 F.3d 977, 888 (Fed. Cir. 2006). No such “articulated reasoning with rational underpinning” has been provided here by the Examiner.

All that the Examiner has done is identify a single compound in laundry list of compounds. But he has provided no rational explanation as to why one would have picked and chosen this compound. Accordingly, because the Examiner has provided no evidence of a motivation to combine the cited reference, the rejection is improper and should be withdrawn.

C. Matsunaga in view of Cauwet

The Examiner has rejected claims 17-20 under 35 U.S.C. § 103(a) over *Matsunaga* in view of U.S. Patent No. 5,853,708 to Cauwet et al. ("*Cauwet*") for the reasons disclosed on page 6 of the Office Action. Applicants respectfully traverse this rejection.

The Examiner concedes that *Matsunaga* does not teach the specific oils recited in claims 17-20. *Office Action*, page 5. Thus, the Examiner relies on *Cauwet* for the teachings of the limitations in those claims. *Id.* The Examiner contends the proposed combination "would be" obvious because *Matsunaga* teaches the use of a genus of hydrocarbons and animal and vegetable oils and *Cauwet* teaches the specific species. *Id.* Thus, according to the Examiner, one skilled in the art "would be" motivated to incorporate *Cauwet*'s poly- α -olefins into *Matsunaga*'s composition. *Id.* Applicants disagree.

As discussed above, and re-emphasized here, *Matsunaga* does not disclose or suggest hair dye compositions comprising the fluorescent dyes corresponding to formulae (F1), (F3), and/or (F4). Accordingly, the further combination of this reference with *Cauwet* must fail because *Cauwet* does not cure the failings of the underlying

reference. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection over claims 17-20.

D. Matsunaga in view of Vandebossche

The Examiner has rejected claims 23-26 under 35 U.S.C. § 103(a) over *Matsunaga* in view of U.S. Patent No. 6,391,062 to Vandebossche ("*Vandebossche*") for the reasons disclosed on page 7 of the Office Action. Applicants respectfully traverse this rejection.

Because *Matsunaga* fails to teach the claimed species of direct dye, the Examiner looks to *Vandebossche* for this teachings. *Id.* *Matsunaga*, however, does not disclose or suggest hair dye compositions comprising fluorescent dyes corresponding to formulae (F1), (F3), and/or (F4). Accordingly, the further combination of this reference with *Vandebossche* necessarily fails because *Vandebossche* does not teach or suggest the claimed fluorescent dyes. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection over claims 23-26.

E. Matsunaga in view of Giuseppe

The Examiner has rejected claim 27 under 35 U.S.C. § 103(a) over *Matsunaga* in view of U.S. Patent No. 5,744,127 to Giuseppe et al. ("*Giuseppe*") for the reasons disclosed on page 8 of the Office Action. Applicants respectfully traverse this rejection.

Matsunaga also fails to teach that its composition can be in the form of a dyeing shampoo, accordingly, the Examiner relies on *Giuseppe* for this teachings. *Id.* *Matsunaga*, however, does not disclose or suggest hair dye compositions comprising fluorescent dyes corresponding to formulae (F1), (F3), and/or (F4). Accordingly, this further proposed combination with *Giuseppe* is improper because *Giuseppe* does not

teach or suggest the claimed fluorescent dyes. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection over claims 27.

F. Matsunaga in view of Saunier

Finally, the Examiner has rejected claim 37 under 35 U.S.C. § 103(a) over *Matsunaga* in view of U.S. Patent No. 5,744,127 to Saunier et al. ("*Saunier*") for the reasons disclosed on page 8 of the Office Action. Applicants respectfully traverse this rejection.

According to the Examiner, *Matsunaga* also fails to teach peroxidases as an oxidizing agent in a dyeing composition, accordingly, the Examiner relies on *Saunier* for this teachings. *Id.* *Matsunaga*, however, does not disclose or suggest hair dye compositions comprising fluorescent dyes corresponding to formulae (F1), (F3), and/or (F4). Accordingly, the further combination of this reference with *Saunier* must fail because *Saunier* does not cure the deficiencies of the underlying reference. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection over claims 37.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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